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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/962,271	10/31/1997	GARY A. FREEMAN	04644/068001	8658

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BOSTON, MA 02110

EXAMINER
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FOSTER, JIMMY G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 02/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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41

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Commissioner for Patents

Jimmy G Foster  
Primary Examiner  
Art Unit: 3728

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1. On 31 October 2003, this application was remanded from the Board of Patent Appeals and Interferences to the examiner in order to reconsider the appropriateness of the final rejection of claims 23, 26, 27 and 29-48 under 35 U.S.C. 251, regarding the issue of improper recapture of surrendered subject matter. The remand was in light of the precedential opinion of Ex parte Eggert et al, Appeal No. 2001-0790 (Bd. Pat App & Inter. May 29, 2003).

2. A resultant review by the examiner has determined that the rejection under 35 U.S.C. 251, regarding recapture, does not run counter to the opinion set forth in Ex parte Eggert.

However, in view of reasons separate from Ex parte Eggert, the examiner **hereby withdraws the rejection** of claims 23, 26, 27 and 29-48 under 35 U.S.C. 251, regarding improper recapture, as being inappropriate with respect to prevailing case law.

The present fact situation is most analogous to B.E. Meyers & Co. v. United States, 56 USPQ2D 1110 (USCtFedCls 2000). The Court of Federal Claims permitted the complete removal of a limitation that was added to obtain the patent, where the replacement limitation provided a separate invention not surrendered in the original application. It is to be noted that adding a different invention (e.g. a new embodiment or species) via reissue was expressly approved by the Federal Circuit in In re Amos, 953 F.2d 613, 21 USPQ2D 1271 (Fed. Cir. 1991) and in In re Doyle, 293 F.3d 1355, 63 USPQ2D 1161 (Fed Cir. 2002). If an unclaimed different invention is then added (i.e. newly claimed) via reissue, it may very well omit a limitation added to narrow the first invention and define over the prior art, since the content and context of the newly claimed invention may very well be different in

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nature than the first invention and may rely on a different way of accomplishing the inventive concept that does not use the limitation(s) of the first invention that was narrowed.

In the present instance, even though the reissue claims omit limitations regarding the resealable seal adapted to seal the compartment and regarding the barrier element being positioned at the releasable seal, there is no recapture since the reissue claims are directed to a different invention and have a different focus than the claims examined in the original application. The reissue claims deal with an electrode package having a particular wiring configuration, including a connector body comprising a first end exposed to the interior of the compartment and the terminal being non-unitary with the lead wire. This wiring configuration is not directed to the focus of the electrode packaging having a releasable seal folding configuration. Thus even though the reissue claims omit the releasable seal limitation argued in the original application, as distinguishing over the prior art, there is no recapture in the present reissue application, since the reissue claims are directed to a different invention and to a different focus than that of the claims examined in the original application and patented.

3. However, the following outstanding rejection remains in this application:

4. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed since specific amendments to the claims

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have been made which were not addressed by the declaration of April 6, 2000 or by the original declaration.

Claim 1-12, 14, 18, 20-23, 26, 27, 29-51 remain therefore rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

5. Moreover, The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

6. Inasmuch as the remaining rejection of the reissue claims under 35 U.S.C 251 was already made in the final action and will be overcome by merely filing of a supplemental reissue oath or declaration, Applicant is given a **ONE MONTH** time period in which (1) to file the supplemental reissue declaration and (2) to submit the original letters patent in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

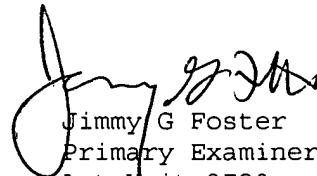
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy G Foster whose telephone number

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is (571) 272-4554. The examiner can normally be reached on Mon-Fri, 8:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Jimmy G Foster  
Primary Examiner  
Art Unit 3728

JGF  
27 January 2005